

REMARKS

Pending claims 1-19, 21, 22, 25-31, 33-36, 38 and 39 stand rejected.

Claims 35, 36, 38 and 39 have been amended.

Reconsideration of this application is respectfully requested.

Claim Rejections Under 35 U.S.C. § 101

Claims 35, 36, 38 and 39 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The examiner states that claims 35, 36, 38 and 39 are directed to a “computer readable medium, which could include the disclosed storage medium, or the disclosed transmission medium.” The examiner states that this “leaves open the possibility that the claimed computer program code is embodied in a signal, which is non-statutory.” (Office Action at page 4).

In response, the preambles of claims 35, 36, 38 and 39 have been amended to recite “[a] computer readable storage medium with computer program code,” Thus, amended claims 35, 36, 38 and 39 are directed to statutory subject matter. Withdrawal of the rejection is kindly requested.

Rejection of claims 19, 27, 28, 30 and 35 Under 35 U.S.C. § 103

The examiner rejects claims 19, 27, 28, 30 and 35 under 35 U.S.C. §103(a) as being unpatentable over Rivette et al. (U.S. patent No. 5,991,751) in view of Getchius et al. (U.S. patent No. 6,393,415). These rejections are traversed.

The examiner states that Rivette fails to teach a search method including “automatically using at least one additional name for searching, wherein said additional name is obtained from

an entity names table, and wherein said table identified said additional name as representative of said same entity,” But the examiner contends that Getchius’s disclosure of expanding query terms through the use of synonyms and other terms that are semantically related to the terms when combined with the teachings of Rivette renders the claimed invention obvious to one of ordinary skill in the art at the time of the invention. The examiner states that it would have been obvious “to expand queries for entities [assignees] to include additional names representative of the same entity [assignee], particularly in light of the fact that query expansion in general was well known at the time of the invention” (Office Action at page 8).

Applicant disagrees with this conclusion because although the combined teachings of Rivette and Getchius may teach the general concept of expanding the assignee query term, it does not make it obvious to achieve that expansion by “automatically using at least one additional name for searching, wherein said additional name is **obtained from an entity names table**,” as required by the independent claims 19, 30 and 35. The combined teachings of Rivette and Getchius does not teach or suggest the use of “an entity names table.”

Accordingly, Applicant believes that the independent claims 19, 30 and 35 are allowable over the cited references. Withdrawal of the rejection and allowance of claims 19, 30 and 35 are kindly requested.

Claims 27 and 28 depend from claim 19 which is allowable over the cited references. Because dependent claims incorporate all limitations of the parent claim, claims 27 and 28 are also allowable over the cited references, the combination of Rivette and Getchius. Withdrawal of the rejection and allowance of claims 27 and 28 are kindly requested.\

Rejection of claim 21 Under 35 U.S.C. § 103

The examiner rejects claim 21 under 35 U.S.C. §103(a) as being unpatentable over Rivette in view of Getchius and further in view of Hammond (U.S. patent No. 7,139,755). This rejection is traversed.

Claim 21 depends from claim 19 and further requires a step of “translating said search query comprising at least one patent identification condition and including a name of an entity from a first content language to a second content language.” The examiner rejects claim 21 based on the cited combination of references because the examiner states that the “translating” step of claim 21, although not disclosed by the combination of Rivette and Getchius, is disclosed in Hammond. Thus, the examiner contends that the combination of Rivette, Getchius and Hammond obviates the claimed invention.

However, as discussed above in connection with the allowability of claim 19, Applicant’s position is that the combination of Rivette and Getchius fails to teach or suggest the use of the entity name table to automatically add additional equivalent names for the assignee name. And the disclosure of Hammond also fails to teach or suggest that limitation. Thus, the combined disclosures of Rivette, Getchius and Hammond fails to teach or suggest the invention claimed in claim 21. The combined disclosures of Rivette, Getchius and Hammond does not render the claimed invention obvious under 35 U.S.C. § 103.

Withdrawal of the rejection of claim 21 and its allowance are kindly requested.

Rejection of claims 29, 34 and 39 Under 35 U.S.C. § 103

The examiner rejects claims 29, 34 and 39 under 35 U.S.C. §103(a) as being unpatentable over Rivette in view of Getchius and further in view of Tanner et al. (U.S. patent application publication No. 2004/0243588). These rejections are traversed.

Similar to the independent claims 19, 30 and 35 discussed above, all three independent claims 29, 34 and 39 recite a limitation that requires that at least one additional name for searching and that additional name be obtained from an entity name table. And as discussed in connection with the allowability of claims 19, 30 and 35, the combination of Rivette and Gechius fails to teach or suggest that recited limitation. And the disclosure of Tanner also fails to teach or suggest that limitation. Thus, the combined disclosures of Rivette, Getchius and Tanner fails to teach or suggest the invention claimed in claims 29, 34 and 39. The combined disclosures of Rivette, Getchius and Tanner does not render the claimed invention obvious under 35 U.S.C. § 103.

Withdrawal of the rejection of claims 29, 34 and 39 and their allowance are kindly requested.

Rejection of claims 22, 31 and 36 Under 35 U.S.C. § 103

The examiner rejects claims 22, 31 and 36 under 35 U.S.C. §103(a) as being unpatentable over Rivette in view of Getchius and further in view of Tanner et al. (U.S. patent application publication No. 2004/0243588). These rejections are traversed.

Claims 22, 31 and 36 recite “generating a notice to a predetermined person when said owner of said first tier reference patent matches a predetermined entity.” The examiner rejects claims 22, 31 and 36 based on the cited combination of references because the examiner states

that the limitation recited in claims 22, 31 and 36, although not disclosed by the combination of Rivette and Getchius, is disclosed in Tanner. The examiner, thus, contends that the combination of Rivette, Getchius and Tanner obviates the claimed invention.

However, claims 22, 31 and 36 depends from claims 19, 30 and 35, respectively. And as discussed above in connection with the allowability of the parent claims 19, 30 and 35, the combination of Rivette and Getchius fails to teach or suggest the use of the entity name table to automatically add additional equivalent names for the assignee name recited in the parent claims. This deficiency is not corrected by the additional disclosure of Tanner because Tanner also fails to teach or suggest the use of the entity name table. Thus, the combined disclosures of Rivette, Getchius and Tanner fails to teach or suggest the invention claimed in claims 22, 31 and 36. The combined disclosures of Rivette, Getchius and Tanner does not render the claimed invention obvious under 35 U.S.C. § 103.

Withdrawal of the rejection of claims 22, 31 and 36 and their allowance are kindly requested.

Rejection of claims 25, 26, 33 and 38 Under 35 U.S.C. § 103

The examiner rejects claims 25, 26, 33 and 38 under 35 U.S.C. §103(a) as being unpatentable over Rivette in view of Getchius and further in view of Dialog (“Patent Research for Competitive Intelligence”). These rejections are traversed.

Claims 25, 26, 33 and 38 are dependent claims and the examiner states that the limitation recited in these claims, although not taught or suggested by the combination of Rivette and Getchius, is disclosed in the Dialog reference. Thus, the examiner contends that the combination of Rivette, Getchius and Dialog obviates the claimed invention.

However, claims 25, 26, 33 and 38 depends from claims 19, 30 and 35, respectively. And as discussed above in connection with the allowability of the parent claims 19, 30 and 35, the combination of Rivette and Getchius fails to teach or suggest the use of the entity name table to automatically add additional equivalent names for the assignee name recited in the parent claims. This deficiency is not corrected by the additional disclosure of Dialog because Dialog also fails to teach or suggest the use of the entity name table. As already presented in Applicant's previously submitted Amendment in response to the Office Action of June 27, 2006, Dialog does not disclose the use of the entity name table to automatically add additional equivalent names for the assignee name in the search query. Thus, the combined disclosures of Rivette, Getchius and Dialog fails to teach or suggest the invention claimed in claims 25, 26, 33 and 38. The combined disclosures of Rivette, Getchius and Dialog does not render the claimed invention obvious under 35 U.S.C. § 103.

Withdrawal of the rejection of claims 25, 26, 33 and 38 and their allowance are kindly requested.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant submits that this application is in condition for allowance. Reconsideration of the pending claims as amended herein and allowance are kindly requested.

The Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment that may be associated with this communication to deposit account **04-1679**.

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Respectfully submitted,

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